



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,415	02/27/2004	Toru Yano	Q80109	4540

23373 7590 06/27/2006

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

TOSCANO, ALICIA

ART UNIT	PAPER NUMBER
----------	--------------

1712

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/787,415

Applicant(s)

YANO ET AL.

Examiner

Alicia M. Toscano

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,7-9 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7-9 and 11-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Based on an indication of allowable subject matter in original claims 6 and 7, Applicant has amended claim 1 to stipulate the copolymerization of the saccharide with D- and L-lactic acid and claim 7 to stipulate the copolymerization of starch with D- and L- lactic acid. New claims 11-13 have been added. The Examiner has since discovered a new reference which encompasses the limitations of claim 1 of the Applicant, and the indication of allowable subject matter is reversed.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 7-9 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuroki (US Patent 6984443 B2).

Kuroki discloses a polyester resin composition comprising components (2) an aliphatic polyester comprising polyfunctional polysaccharides and lactic acid units and (3) aliphatic polyesters comprising aliphatic polyvalent carboxylic acid units, aliphatic polyvalent alcohol units and lactic acid (column 4 lines 8-12). The term lactic acid used in the invention refers to both D-lactic acid and L-lactic acid (Column 4 Line 18-22). Component (2) comprises reacting polyfunctional polysaccharides, which include cellulose and starch, with lactic acid units (Column 4 Lines 51-57). Production Example

1 (Column 10) discloses the polymerization of L-lactic acid with 0.5 mol% impurity content. D-lactic acid is an inherent impurity in L-lactic acid, and as such the Examiner finds this to suffice for the resin composition of the applicant containing both L-lactic acid copolymer and D-lactic acid copolymer, thus encompassing Claims 1-3. A film, or molded article, which is extruded at a temperature between 100 and 280 degrees C is disclosed in Column 7 Lines 43-52, as required by Claim 9, and 11-13. Kuroki further discloses the use of a copolymer containing (a) lactic acid (b) aliphatic polyalcohol units, or a polyhydric alcohol and (c) aliphatic polyvalent carboxylic acid units, or polybasic carboxylic acid, (Column 5 Lines 5-7), thus encompassing claim 12.

Conclusion

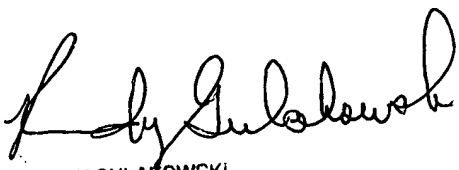
3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kakizawa (US Patent 5686540) discloses the ability to tailor the characteristics of a lactic acid polymer by copolymerizing two or more lactic acids, or D and L-lactic acid (Column 5 Lines 50-52), as well as the use of fillers, such as starch, to enhance the heat resistance and stiffness of the polyester (Column 14 Lines 65-Column 15 Line 3).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia M. Toscano whose telephone number is 571-272-2451. The examiner can normally be reached on Monday to Friday 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMT



RANDY GULAROWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700